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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,498	09/02/2003	Randolf Von Oepen	HO-US005378A	2721
22919	7590	11/01/2006	EXAMINER	
GLOBAL IP COUNSELORS, LLP 1233 20TH STREET, NW, SUITE 700 WASHINGTON, DC 20036-2680			PELLEGRINO, BRIAN E	
			ART UNIT	PAPER NUMBER
			3738	
DATE MAILED: 11/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/652,498

Applicant(s)

VON OEPEN, RANDOLF

Examiner

Brian E. Pellegrino

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,8,10,13,16 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,8,10,13,16 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/9/06 has been entered.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitation that the first and second expanded portions have first and second tapering portions with predetermined lengths and angles was not found in the written disclosure.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3,8,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruiz (6120534) in view of Glastra et al. (EP 0779062). Ruiz discloses (Figs. 2A,2B) a stent configured and arranged to expand with first and second expanding fixing portions **11,12** and a throttle portion **13** coupled to the first and second portions. Ruiz shows (Fig. 3) a catheter **21** having balloons to expand the stent with reduced expandability.

Ruiz also shows (Figs. 5B,5C) a liquid impermeable cover **52** on the stent. Ruiz discloses the covering is an elastomeric material, col. 5 lines 47-49. Ruiz discloses the cover is PTFE, col. 3, lines 40,41. However, Ruiz fails to disclose the expansion is a done by a single balloon. Glastra et al. show (Fig. 6) a stent-catheter arrangement having a balloon **26** with two fully expandable sections **27** and a section of reduced expandability between the expandable sections and thus has first and second tapering portions. It is inherent it has some predetermined length and angles since it is a solid state of matter. It would have been obvious to one of ordinary skill in the art to use a single balloon as taught by Glastra with the stent of Ruiz such that the surgeon has more control in delivering the stent as opposed to manipulating multiple balloons.

Claims 1-3,8,13,16,23,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glastra et al. (EP 0779062) in view of Jaeger (DE 19509464). Glastra et al. show (Fig. 6) a stent-catheter arrangement having a balloon **26** with two fully expandable sections **27** and a section of reduced expandability between the expandable sections. However, Glastra does not disclose a liquid impermeable cover over the stent or a stiffening element for forming a reduced expandable section. Jaeger teaches (Fig. 11) a liquid impermeable cover **6** over stent. Jaeger also teaches (Fig. 3) a stiffening element **5** can be used to form a section of reduced expandability. It would have been obvious to one of ordinary skill in the art to use a blood impermeable cover on the stent and a stiffening element as taught by Jaeger with the stent-catheter system of Glastra et al. in order to provide an outer surface that does not allow blood leakage and to provide a throttle portion to increase blood flow to reduce the likelihood of plaque

buildup. Please note claims 13,16,23,24 are being interpreted as product-by-process claims and are not construed as being limited to the product formed by the specific processes recited. The balloon of Glastra is fully capable of being made to incorporate the stiffening element with the balloon.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glastra (EP 0779062) in view of Jaeger (DE 19509464) as applied to claims 1-3 above, and further in view of Tower (US 5695498). Glastra in view of Jaeger is explained supra. However, Glastra as modified by Jaeger do not disclose the balloon made of stiffened balloon material. Tower discloses that the balloon is formed of stiffened balloon material and that the reduced expandability section is formed during balloon production, col. 3, lines 21-34. It would have been obvious to one of ordinary skill in the art to use stiffened balloon material and produce this reduce expandability section during balloon production as taught by Tower with the catheter-stent system of Glastra as modified by Jaeger in order to strengthen the balloon such that the chance of the balloon collapsing has been greatly reduced.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glastra (EP 0779062) in view of Jaeger (DE 19509464) as applied to claim 13 above, and further in view of Crocker et al. (US 5843116). Glastra in view of Jaeger is explained supra. However, Glastra as modified by Jaeger fail to disclose the stiffening element is integrated in the balloon. Crocker et al. show (Fig. 3) that stiffening material is integrated into the balloon to limit the expansion of the balloon in certain areas, col. 5, lines 29-49. It would have been obvious to one of ordinary skill in the art to utilize the

integrated stiffening material as taught by Crocker et al. with the balloon catheter of Glastra as modified by Jaeger having a stent such that a proper profile can be obtained by integrating the stiffening element in the balloon and provide the matching contour to the vessel site.

### ***Response to Arguments***

In response to applicant's argument that the Ruiz/Glastra combination that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the stent having the larger portions with constant cross-sections) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, Applicant is arguing this feature and states Glastra does not teach a constant cross-section stent, but fails to acknowledge that the Examiner was only taking the teaching of the single balloon used in Glastra, not the stent. In response to applicant's arguments against the Glastra/Jaeger reference combination individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that Jaeger teaches a stent that has a constriction. However, the combination was to take the teaching of a coating on the stent taught by Jaeger and also to form constricted sections using a stiffened portion also taught by Jaeger. The Examiner was not changing the stent of Glastra and substituting the stent

of Jaeger as Applicant implied, but only incorporating a coating onto the stent of Glastra. Applicant also compares the recited process with the prior art uses the devices does NOT serve to resolve the issue of concerning patentability of the product. Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is used is patentable. The claims are directed to apparatus, not methods of use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 7:30am to 5pm. The examiner can also be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

**BRIAN E. PELLEGRINO**  
**PRIMARY EXAMINER**

